



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,397	12/21/2001	Patrick Zuili	SSL1P001/SS-010	3617

7590

09/28/2005

James S. Ferrell
CARR & FERRELL LLP
2200 Geng Road
Palo Alto, CA 94303

EXAMINER

SCHUBERT, KEVIN R

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/028,397		ZUILI, PATRICK	
	Examiner		Art Unit	
	Kevin Schubert		2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

PD

DETAILED ACTION

Claims 1-40 have been considered. The claims are subject to a restriction requirement and an election of species requirement.

5

Requirement for Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22 and 40 are drawn to a method for data processing protection based on receiving a copy selection and preventing subsequent usage of the copy selection if it is secured, classified in class 713, subclass 189 (Electrical Computers and Digital Processing Systems: Data Processing Protection Using Cryptography). Furthermore, the copy selection is determined to be secured based on security information of the source application (claim 21).
- II. Claims 23-25 are drawn to method for stored data protection based on receiving a copy selection and initially storing the designated content and further replacing designated stored content with alternate content when it is determined to be secured, classified in class 713, subclass 193 (Electrical Computers and Digital Processing Systems: Data Processing Protection Using Cryptography: By Stored Data Protection).
- III. Claims 26-39 are drawn to method for data processing protection based on launching a first application when a request to access a file is received, determining whether the file is secured, and loading the file in clear mode while activating a clipboard security monitor when the file is determined to be secured in order to ensure that the file cannot be copied to a second application, classified in class 713, subclass 189 (Electrical Computers and Digital Processing Systems: Data Processing Protection Using Cryptography). Furthermore, the file is determined is determined to be secure by analyzing the header (claim 27).

The inventions are distinct each from each other because:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are said to be distinct from each other if it can be shown that they are separately usable. In the instant case invention II has separate utility because it relates to initially storing the copy selection and then replacing the copy selection with alternate content if the initially stored content is determined to be secure. See MPEP 806.05(d).

Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The inventions are said to be distinct from each other if it can be shown that they are separately usable. In the instant case invention III has separate utility because it relates to launching a first application when a request to access a file is received and activating a clipboard security monitor to ensure that no contents in a secured file can be copied into a second application. Additionally, invention III relates to preventing copying of a file, and accordingly ascertaining security information based on the file header (claim 27), while invention I relates to preventing copying of a copy selection, and obtaining security information from the source application (claim 21). See MPEP 806.05(d).

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. Inventions are said to be distinct from each other if it can be shown that they are separately usable. In the instant case invention II has separate utility because it relates to initially storing the copy selection and then replacing the copy selection with alternate content if the initially stored content is determined to be secure. See MPEP 806.05(d).

Because the inventions are distinct for the reasons given and have acquired at least two separate classifications in the art, restriction for examination purposes is proper. Further, the examiner notes the burden in examining invention III because it requires additional searching for preventative copying of a file (ie 713/165) and for searching for access control mechanisms associated with the launching and activation of the first application and the clipboard security monitor (ie 726/27).

Requirement for Election of Species

Art Unit: 2137

In addition to the restriction requirement, invention I contains 3 patentably distinct species. The species differ based on three distinct characteristics (see applicant's Specification [0022]). The three distinct characteristics are: whether the alternate content stored to the clipboard application instead of the designated content is (1) blank content, (2) predetermined content, or (3) scrambled content. If invention

5 I is selected, one of the following species must also be selected:

a. storing blank content to the clipboard application instead of the designated content (claims 7-

9).

b. storing predetermined content to the clipboard application instead of the designated content (claims 10-12).

10 c. storing scrambled content to the clipboard application instead of the designated content (claims 13-15).

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement if invention I is selected, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all

15 claims are generic is considered nonresponsive unless accompanied by an election.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either case, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35

20 U.S.C. 103(a) of the invention.

A complete response to this action includes an election of the invention to be examined and an election of species if invention I is selected.

25

Conclusion

Art Unit: 2137

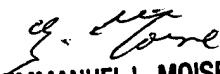
A shortened statutory period for response to this action is set to expire one month (not less than 30 days) from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should
5 be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally
be reached on M-F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,
Emmanuel Moise can be reached on (571) 272-3868. The fax phone number for the organization where
this application or proceeding is assigned is 571-273-8300.

10 Information regarding the status of an application may be obtained from the Patent Application
Information Retrieval (PAIR) system. Status information for published applications may be obtained from
either Private PAIR or Public PAIR. Status information for unpublished applications is available through
Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should
you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC)
15 at 866-217-9197 (toll-free).

KS


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER